

### **REMARKS/ARGUMENTS**

In response to the Office Action mailed October 19, 2004, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, claims 5, 19, 22 and 23 have been cancelled without prejudice, no claims have been added and claims 1, 6, 20, 21 and 24 are amended so that claims 1, 6, 20, 21 and 24 are currently pending. No new matter has been introduced.

Claims 1, 5-6, and 19-24 were rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended Claim 1 to correct the deficiency.

Claims 1, 5, 6, 19 and 22-24 were rejected as being anticipated by U.S. Patent Number 6,325,823 to Horzewski, et al (Horzewski). This rejection is respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

Horzewski discloses an endovascular prosthesis comprising a plurality of telescoping tubular members. The tubular members comprise a polymer covered plastically deformable alloy or metal structure. In one embodiment, one tubular member includes a resilient seal that may be affixed in a number of ways.

The present invention as claimed in amended claim 1 is directed to a bypass system that comprises a first prosthesis, a compressible gasket and at least two bypass prostheses. The first prosthesis include a self-expanding lattice. The graft material nor longitudinally oriented pleats. The compressible gasket is positioned in the distal end of the first prosthesis and comprises at least two apertures. The compressible gasket is configured to engage and seal the at least two bypass prostheses to the first prosthesis.

Horzewski fails to disclose or suggest a device comprising a first prosthesis having a graft with longitudinal pleats or a device having a compressible gasket with at least two apertures. Since Horzewski fails to disclose these features, there can be no anticipation. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1, 5, 6, 19 and 21-24 were rejected as being anticipated by U.S. Patent Application No. US 2003/0120333 to Ouriel et al (Ouriel). This rejection is respectfully traversed.

Ouriel discloses an endovascular prosthesis that comprises a tubular structure on one end and a furcated second end for accepting branch legs. The component of the device are fabricated utilizing stents covered with two graft layers 156,157 (see IP 0097).

Ouriel fails to disclose or suggest a device. Ouriel fails to disclose or suggest a device comprising a first prosthesis having a graft with longitudinal pleats or a device having a compressible gasket with at least two apertures. Since Ouriel fails to disclose these features, there can be no anticipation. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 20 was rejected as being unpatentable over Horzewski. This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re* Vaeck, 947 F.2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 – § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

Horzewski fails to disclose or even remotely suggest all of the claimed elements of amended claim 1. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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